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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-----------------|----------------------|-----------------------------|------------------|
| 10/071,726 | 02/08/2002 | Jeffrey R. Moritz | P00548-US-1 (14913.0020) | 3222 |
| | 7590 07/30/2004 | | EXAMINER GORDON, BRIAN R | |
| Russell E. Fowler, II ICE MILLER One American Square Box 82001 Indianapolis, IN 46282-0002 | | | ART UNIT 1743 | |
| DATE MAILED: 07/30/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/071,726 | Applicant(s) MORITZ ET AL. | |
| | Examiner Brian R. Gordon | Art Unit 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-16 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-8-02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10-15-02; 2-8-02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Figure 1 as described in the "Background" appears to be prior art.

Specification

2. The disclosure is objected to because of the following informalities: On page 2-3 the tips are designated as reference numerals 20 and 30.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

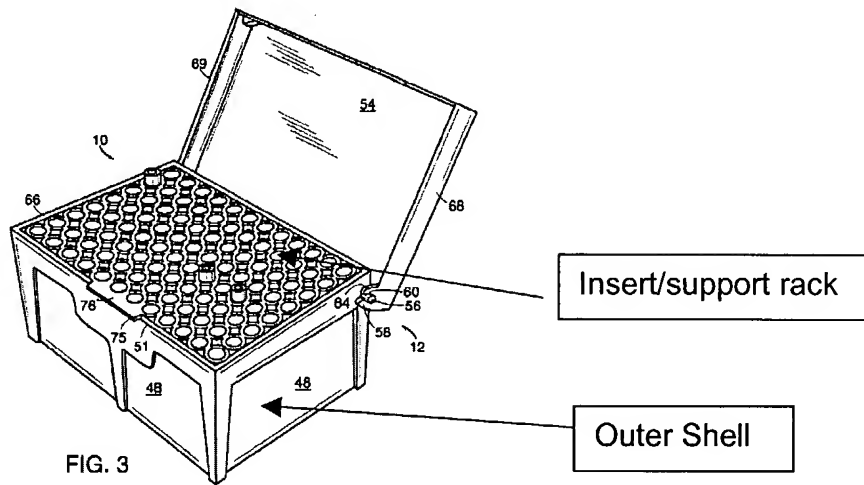
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalmakis et al. US 6,019,225 in view of Hirsh US 5,190,727 and further in view of Liu US 6,015,064.

Kalmakis et al. disclose an improved pipette tip support rack having a honeycomb structure. The rack includes an array of interconnected sleeves, each of the sleeves being constructed to support a pipette tip therein. The sleeves are connected by bridges which form along abutting, touching surfaces thereof, or which extend between non-touching sleeves. Openings are formed between adjacent ones of said sleeve which occupy substantially all of the space between adjacent sleeves not occupied by the bridges. Inwardly extending lips on the interior of each sleeve support the enlarged portion of the pipette tip and provide a channel through which the stem extends. Interior side walls of each sleeve provide lateral support to the pipette tips. The tray may be used in conjunction with a container to provide ventilation during autoclaving. The tray

snaps into the container and rests on shoulders therein. A finger tab is provided for lifting the tray out of the container.



As seen in Figure 3, the rack device is comprised of sleeve insert or tray 10 container 12.

Typically, tray 10 is injection-molded and formed of a plastic material. A typical example of the material of which tray 10 may be formed is polypropylene. However, it will be appreciated that tray 10 may be formed of any other material, such as aluminum (electrically conductive), which can be autoclaved and which provides the desired structural support and rigidity. Container 12 typically is formed of the same material as tray 10 and also is molded, although it will again be appreciated that other materials and techniques may be used to form container 12.

Kalmakis et al. does not disclose the device of comprising an electrically conductive material or that the device is to be used to discharge static charges from pipette tips.

Hirsch discloses a device for translatorily moving a plate-shaped pipette tray to the processing station of an analyzer for alignment therein. The pipette tray which frictionally rests on a continuous movement device is thereby moved up to a stop member and roughly aligned. During the pipetting process, the tray may develop a static charge; therefore it is desirable to remove the charge.

Preferably, stop member 23 comprises an electrically conductive material and is connected to ground through the rest of the apparatus, in a conventional manner, so that member 23 will function to discharge electrostatic charges that build up in a tray as the movement means 16 continues to push it against member 23.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize as taught by Hirsch when components of a pipetting device are frictionally engaged and disengaged (as in the attachment and detachment of pipette tips) an active static charge may develop on the components.

Liu discloses a portable closable container has individually closable cells under a main lid. The container has a base with which the main lid defines an internal space. The internal space is partially filled by a plurality of side-by-side, top-to-bottom individual cells. Each of the cells is fitted with a removable cover which is hingedly mounted to the cell.

The container hand-portable molded plastic closable, resealable containers for storing multiple pieces of several different objects of the same general kind, and in particular to lightweight, easily transported, robust, molded plastic storage containers

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with repeatedly closable covers fitted to a plurality of individual cells for storing several dozen or more different objects of the same general size and type.

The typical static discharge generated by handling the components does not normally present any problems. But, in the event of the storage of active components within the container, it is practical to provide a conductive plastic out of which to make the container.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Kalmakis by manufacturing the device from an electrically conductive plastic material in order to remove a charge from the pipette tips stored in the rack or to prevent a charge from building up on the container.

Allowable Subject Matter

7. Claims 4-7 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest the face and the at least one sidewall are formed of a conductive plastic material impregnated with carbon and the face and the at least one sidewall are formed of a conductive plastic material impregnated with metal flakes, metal powder or metal strands.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Higuchi, Akira; Hughes, Kevin et al.; Jackson, Joseph H. III et al.;

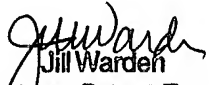
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Arnold, Robert W. JR. et al.; Labriola, Anthony M. et al.; Gora, Heinz-Jurgen; Viot, Francois et al.; Lahti, Arto et al.; Petrek, James S.; Brophy, John M. et al.; Carl, Richard A.; Lahti, Arto; Lemieux, David J. et al.; Steinbrenner, Bernd et al.; Nakashima, Hidetoshi et al.; Uchida, Hiroyasu et al.; Komiyama, Yasuaki et al.; Hill, Bob et al.; Honda, Hisashi; Rainin, Kenneth et al.; Cohen, Jules B.; Taggart; Kelly et al.; Asa et al. and Smernoff, Ronald B. disclose storage and rack containers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

brg

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